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# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail  $\,$  address(es):

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 Application No.
 Applicant(s)

 10/529,864
 ROSADO, TERESA MARIA

 Examiner
 Art Unit

 MARCOS L TORRES
 2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  Extensions of time may be available under the provisions of 37 CFR 1.33(a). In no event, however, may a reply be timely filled.  If NO prind for reply is specified above, the maximum statutory period wit apply and will expire SIX (5) MONTHS from the maining date of this communication. Failure to reply within the set or extended period for reply will by that set, cause the application to become ABADONED (38 U.S.C. § 133). Any reply received by the Office later than three months after the maining date of this communication, even if timely filled, may reduce any earned patter term adjustments. See 37 CFR 1.74(b).
Status
Responsive to communication(s) filed on <u>07 January 2009</u> .  2a)    This action is <b>FINAL</b> .    2b)    This action is non-final.  3)    Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.
Disposition of Claims
4) Claim(s) <u>26-47</u> is/are pending in the application.  4a) Of the above claim(s) is/are withdrawn from consideration.  5) Claim(s) is/are allowed.  6) Claim(s) <u>26-47</u> is/are rejected.  7) Claim(s) is/are objected to.  8) Claim(s) are subject to restriction and/or election requirement.
Application Papers
9) ☐ The specification is objected to by the Examiner.  10) ☑ The drawing(s) filed on 1-7-09 is/are: a) ☑ accepted or b) ☐ objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(c  11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.
Priority under 35 U.S.C. § 119
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) I b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No
application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)		
1) ∑ Notice of References Cited (PTO-892) 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) ☐ Information Disclosure Statement(e) (PTO/SE/CO) Pager Nots/Mail Date	4) Interview Summary (PTO-413) Paper No(s)/Mail Date. 5) Notice of Informal Patent Application. 6) Other:	
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### DETAILED ACTION

#### Response to Arguments

 Applicant's arguments with respect to the new claims have been considered but are moot in view of the new ground(s) of rejection.

### Claim Rejections - 35 USC § 112

- The following is a quotation of the first paragraph of 35 U.S.C. 112:
  - The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
- 3. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner was not able to find support for the limitation directly communicating the mobile phone transmitting/receiving unit and antenna of the PABX with any mobile phone that is integrated into the communication system as an extension is via a frequency independent transmission.
- 4. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. The examiner was not able to find support for the limitation transmission not dependent on frequency, frequency band or modulation can be done.

- 5. Claim 38 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner was not able to find support for the limitation: the communication system wherein identifying a mobile phone is done by more than one PABX.
- 6. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner was not able to find support for the limitations: "a CPU of the PABX immediately integrates the mobile phone extension in the PABX" and "the CPU of the PABX immediately integrates the mobile phone extension in the PABX as an internal extension of the PABX".
- The following is a quotation of the second paragraph of 35 U.S.C. 112:
   The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how directly communicating the mobile phone transmitting/receiving unit and antenna of the PABX with any mobile phone that is integrated into the communication system as an extension is via a frequency independent transmission can be done.

- 9. Regarding claim 29, the phrase "other legally allowed frequencies" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "other legally allowed frequencies"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
- 10. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how transmission not dependent on frequency, frequency band or modulation can be done.
- 11. Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim recite the limitation "a network", since the parent claim recite internal and external network it is unclear to which one the claim is being refer or if it is a new network. For examination purposes it would be internal.

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### .Claim Rejections - 35 USC § 103

 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior at are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 13. The factual inquiries set forth in *Graham* v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  - Determining the scope and contents of the prior art.
  - Ascertaining the differences between the prior art and the claims at issue.
  - 3. Resolving the level of ordinary skill in the pertinent art.
  - Considering objective evidence present in the application indicating obviousness or nonobviousness.
- Claims 26, 29-33, 35, 39-40 and 47 are rejected under 35 U.S.C. 103(a)
   as being unpatentable over the admitted prior art in view of Ghoi 6775556.

As to claim 26, the admitted prior art teaches what is common and well-known in the PABX system comprising: a PABX for an internal network and configured to connect to external networks (see par. 0054); and a plurality of extensions for connecting to the internal network and to the external network via the PABX (see par. 0052), wherein the plurality of extensions include at least one mobile phone that is configured to be connected to an external mobile phone network using a wireless carrier (see par. 0025), the PABX includes a CPU having a memory (see par. 0003), a power supply and power supply circuits (see par. 0004), software that enables the CPU to perform the functions of answering,

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making and transferring phone calls and (see par. 0035, 0036), and a mobile phone transmitting/receiving unit and antenna for directly communicating with any mobile phone that is integrated into the communication system as an extension for connecting to the internal network, and the at least one mobile phone integrated into the communication system as an extension connects to the internal network via the mobile phone transmitting/receiving unit and antenna of the PABX, to the external network via the mobile phone transmitting/receiving unit and antenna of the PABX (see par. 0002, 0025, 0032, 0054). The admitted prior art fails to teach the external mobile phone network via direct communication using the wireless carrier without using the mobile phone transmitting/receiving unit and antenna of the PABX, detecting, identifying and integrating mobile phones into the communication system as extensions for connecting to the internal network, fixed and mobile network circuits, detection and reversible circuits for switching from an extension to a trunk line or a network and for switching from the trunk line or the network to the extension. In an analogous art, Ghoi discloses detecting, identifying and integrating [registering] mobile phones into the communication system as extensions for connecting to the internal network, fixed and mobile network circuits, detection and reversible circuits for switching from an extension to a trunk line or a network and for switching from the trunk line or the network to the extension, the external mobile phone network via direct communication using the wireless carrier without using the mobile phone transmitting/receiving unit and antenna of the PABX (see col. 4, lines 40-64; col. 6, line 60 - col. 7, line 12, 25-47; col. 9, line 1 - col. 10, line

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12). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to implement multiple connections to the PABX and permit the PABX to operate in the most efficient or least cost connection.

As to claim 29, Ghoi discloses the communication system wherein directly communicating the mobile phone transmitting/receiving unit and antenna of the PABX with any mobile phone that is integrated into the communication system as an extension is via a radio communication, which is not disclosed by the admitted prior art (see col. 4, lines 40-64; col. 6, line 60 – col. 7, line 12, 25-47; col. 9, line 1 – col. 10, line 12).

As to claim 30, Ghoi discloses the communication system wherein phone calls received by the PABX either from fixed or from mobile telephone networks are transferred, which is not disclosed by the admitted prior art (see col. 4, lines 40-64; col. 6, line 60 – col. 7, line 12, 25-47; col. 9, line 1 – col. 10, line 12).

As to claim 31, Ghoi discloses the communication wherein phone calls made from the PABX are transferred either from fixed or from mobile telephone networks, which is not disclosed by the admitted prior art (see col. 4, lines 40-64; col. 6, line 60 – col. 7, line 12, 25-47; col. 9, line 1 – col. 10, line 12).

As to claim 32, Ghoi discloses the communication system wherein the mobile phone can also access to PABX authorized services, which is not disclosed by the admitted prior art (see col. 4, lines 40-64; col. 6, line 60 - col. 7, line 12, 25-47; col. 9, line 1 - col. 10, line 12).

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As to claim 33, Ghoi discloses the communication system wherein the plurality of extensions include a plurality of fixed extensions and a plurality of mobile phones, which is not disclosed by the admitted prior art (see col. 4, lines 40-64; col. 6, line 60 – col. 7, line 12, 25-47; col. 9, line 1 – col. 10, line 12).

As to claim 35, Ghoi discloses the communication system wherein the detection and reversible circuits comprise detection circuits for registering the mobile phone which includes identification (see col. 4, lines 40-64; col. 6, line 60 – col. 7, line 12, 25-47; col. 9, line 1 – col. 10, line 12). The prior reference fails to disclose identifying mobile phones after communication has been established. However, this is an inherent feature since you need to receive something in order to be able to identify it.

As to claim 39, the admitted prior art discloses the communication system wherein the CPU [003] communication system wherein the CPU performs procedures including answering, making and receiving phone calls (see par. 0035-0036, and integrating mobile phones into the communication system (see par. 0040, 0002, 0025). The detecting and identifying are necessary steps in order to integrate a phone

As to claim 40, the admitted prior art discloses the communication system wherein the CPU [003] comprises a reversible package to enable the PABX, at any time of functioning, to switch from a network to an extension of the PABX (this limitation as show in the 112 rejection is incomplete, for examination purposes the claim is interpreted as the switching matrix using network circuit 0008-0018 and extension circuits 0019-0025; 0002, 0052, 0054).

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As to claim 47, the admitted prior art teaches what is common and wellknown in the PABX system comprising: a PABX for an internal network and configured to connect to external networks (see par. 0054); a mobile phone transmitting/receiving trait and antenna connected to the PABX (see par. 0002) and a plurality of extensions for connecting to the internal network and to the external network via the PABX (see par. 0052), wherein the plurality of extensions include at least one mobile phone that is configured to be connected to an external mobile phone network using a wireless carrier (see par. 0025), the PABX includes a CPU having a memory (see par. 0003), a power supply and power supply circuits (see par. 0004), software that enables the CPU to perform the functions of answering, making and transferring phone calls and (see par. 0035, 0036), and a mobile phone transmitting/receiving unit and antenna for directly communicating with any mobile phone that is integrated into the communication system as an extension for connecting to the internal network. and the at least one mobile phone integrated into the communication system as an extension connects to the internal network via the mobile phone transmitting/receiving unit and antenna of the PABX, to the external network via the mobile phone transmitting/receiving unit and antenna of the PABX (see par. 0002, 0025, 0032, 0054). The admitted prior art fails to teach the external mobile phone network via direct communication using the wireless carrier without using the mobile phone transmitting/receiving unit and antenna of the PABX, detecting, identifying and integrating mobile phones into the communication system as extensions for connecting to the internal network, fixed and mobile network

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circuits, detection and reversible circuits for switching from an extension to a trunk line or a network and for switching from the trunk line or the network to the extension. In an analogous art, Ghoi discloses detecting, identifying and integrating [registering] mobile phones into the communication system as extensions for connecting to the internal network, fixed and mobile network circuits, detection and reversible circuits for switching from an extension to a trunk line or a network and for switching from the trunk line or the network to the extension, the external mobile phone network via direct communication using the wireless carrier without using the mobile phone transmitting/receiving unit and antenna of the PABX (see col. 4, lines 40-64; col. 6, line 60 – col. 7, line 12, 25-47; col. 9, line 1 – col. 10, line 12). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to implement multiple connections to the PABX and permit the PABX to operate in the most efficient or least cost connection.

15. Claims 27, 34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Ghoi as applied to claim 26 above, and further in view of Forte.

As to claims 27 and 34, Ghoi discloses the communication system wherein directly communicating the mobile phone transmitting/receiving unit and antenna of the PABX with any mobile phone that is integrated into the communication system as an extension is via a cellular oriented communication (see col. 6, line 40 – col. 7, line 12, 25-47). The prior references fail to teach

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including GSM, UMTS, TDMA, CDMA, AMPS, NAMPS, ETACS or a frequency independent transmission. In an analogous art, Forte discloses a system according characterized in that the communication's transmission line between a mobile phone and a PABX is a cellular oriented communication like GSM, TDMA, CDMA, AMPS [see par. 0023]. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to use any commonly available protocol for the simple purpose of compatibility.

As to claims 36-37, the prior references disclose everything as shown above except for a communication system wherein identifying a mobile phone is made by a code sent through the mobile phone. In an analogous art, Forte discloses a communication system wherein identifying a mobile phone is made by a code sent through the mobile phone is done automatically (see par. 0029). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to combine these teachings for the simple purpose of security.

16. Claims 28 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Ghoi as applied to claim 26 above, and further in view of Freeny.

As to claims 28 and 34, Ghoi discloses wherein directly communicating the mobile phone transmitting/receiving unit and antenna of the PABX with any mobile phone that is integrated into the communication system as an extension (see col. 6, line 40 – col. 7, line 12, 25-47). The above references do not

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specifically disclose is via a satellite communication. In an analogous art, Freeny Jr. discloses wherein directly communicating is via a satellite communication [see par. 0023]. Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to use any common available transmission line to bring the same predictable result of carrying the communication.

17. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Ghoi as applied to claim 35 above, and further in view of Makkonen 5594777.

As to claim 38, the prior references fails to teach the communication system wherein identifying a mobile phone is done by more than one PABX. In an analogous art, Makkonen discloses the communication system wherein identifying a mobile phone is done by more than one PABX (see col. 6, line 6-55). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to repeat the process with more than PABX to have the same advantages of the modified PABX and to support different PABX groups.

 Claims 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Makkonen 5594777.

As to claim 41, the admitted prior art discloses communication method for integrating at least a [DECT, PHS] mobile phone in a PABX and allowing system

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operation of development, processing and progress including answering, making and transferring phone calls, and detecting, identifying and integrating mobile phones in the PABX, as well as accessing all services of the PABX as an internal extension of the PABX (see par. 0002, 0032-0051). The admitted prior art does not disclose the limitations shown Makkonen. In an analogous art, Makkonen discloses a communication method for integrating at least a mobile phone in a PABX by establishing a connection and communication between the mobile phone and the PABX via carrying out the following steps: when the PABX starts the connection, the PABX sends to the mobile phone a connection indication signal through a transmission line, the mobile phone accepts the communication, circuits identify the mobile pone as a mobile phone extension and switch the circuits, and the PABX integrates the mobile phone extension in the PABX (see col. 5, lines 15-26); when the mobile phone or the mobile phone extension starts the connection, the mobile phone or the mobile phone extension sends to the PABX a connection indication signal through the transmission line, the PABX accepts the communication, the circuits identifying the mobile phone as a mobile extension and switch the circuits, and the PABX immediately integrates the mobile phone extension in the PABX as an internal extension of the PABX (see col. 5. lines 7-14). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to combine these teachings for the simple purpose of permitting the communication while providing security and avoiding fraudulent use.

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As to claim 42, the admitted prior art discloses memory and CPU (see par. 0003). The admitted prior art does not disclose the limitations shown Makkonen. In an analogous art, Makkonen discloses the method further carrying out the steps of: controlling the mobile phone identification through system detectors and after identification of the mobile phone, assigning the mobile phone with an extension number which corresponds to the mobile phone identification (see col. 5, line 7 – col. 6, line 55). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to combine these teachings for the simple purpose of permitting the communication while providing security and avoiding fraudulent use.

As to claim 43, Makkonen discloses the method carrying out the steps of: commanding a PABX reversible package to switch a communication channel, which is being used by the mobile phone, from a network to an extension of the PABX, which is not disclosed by the admitted prior art (see col. 3, lines 1-42). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to reuse the channels since it is finite resource.

As to claim 44, Makkonen discloses the method further carrying out the steps of: programming an extension number according to an existing mobile phone number, which is not disclosed by the admitted prior art (see col. 5, line 7 – col. 6, line 55). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to combine these teachings

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for the simple purpose of permitting the communication while providing security and avoiding fraudulent use.

As to claim 45, Makkonen discloses the method further carrying out the steps of: assigning and routing PABX accesses or services to the mobile phone extension as though a fixed extension [permanent] of the PABX, which is not disclosed by the admitted prior art (see col. 3, lines 1-58; col. 5, line 7 – col. 6, line 55). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to combine these teachings for the simple purpose of permitting the communication while providing security and avoiding fraudulent use.

 Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Makkonen as applied to claim 41 above, and further in view of Austin 20030162544 and Carlsen 6192254.

As to claim 46, the admitted prior art discloses the use of the CPU (see par. 0003). The admitted prior does not disclose the rest of the limitations. In an analogous art, Makkonen discloses the method wherein a procedure answering a phone call includes the steps of: the PABX receives, from an internal, external, fixed or mobile extension, a number that corresponds to at least one extension that is either a fixed extension or mobile extension, and when the at least one extension is the mobile extension, the PABX integrates an extension circuit with the mobile phone and the mobile phone thereafter operates as a fixed extension which rings and is allowed to answer a phone; making phone calls when at least

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one mobile phone connects through the transmission line to free PABX identification and reversible circuits, which make the identification of the at least one mobile phone and the user, and if authorized, integrating the mobile phone as a mobile extension, allowing the mobile extension to access all PABX services as well as extensions and trunks of the PABX in accordance with restrictions and authorizations that are assigned to the mobile extension as an internal or fixed extension (see col. 3. lines 1-58; col. 5. line 7 - col. 6. line 55). The prior references does not disclose during a phone call between two parts, one of the parts, holds the call and dials a destination mobile extension number, which rings and is allowed to answer the call, and the one of the parts that holds the call disconnects and transfers the held call from the PABX to the mobile phone corresponding to the destination mobile extension number, wherein, the one of the parts that holds the call can communicate with the mobile phone corresponding to the mobile extension number before disconnecting and transferring the held call [this know as transferring a call]. In another analogous art, Austin discloses transferring a call as described above (see par. 0110-0117). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention was made to combine these teachings for the simple purpose of permitting the common and well-known technique of transferring a call. The above reference fails to disclose Direct Dialing Inward (DDI). In another analogous art, Carlsen discloses using Direct Dialing Inward (see col. 5, lines 26-39). Therefore, it would have been obvious to one of the ordinary skills in the art

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at the time of the invention was made to add this technique to allow receiving calls without the need of an operator.

#### Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL.
See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS L. TORRES whose telephone number is (571)272-7926. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/ Supervisory Patent Examiner, Art Unit 2617

/Marcos L Torres/ Examiner, Art Unit 2617